

Application No.: 10/017,965  
Communication Dated: February 18, 2009  
Reply to Notice of: January 14, 2009

MTS-520US4

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Application No.: 10/017,965  
Applicants: Mitsuki OSHIMA et al.  
Filed: December 7, 2001  
Title: MARK FORMING APPARATUS, METHOD OF FORMING LASER  
MARK ON OPTICAL DISK, REPRODUCING APPARATUS, OPTICAL  
DISK AND METHOD OF PRODUCING OPTICAL DISK  
TC/A.U.: 2137  
Examiner: Paul E. Callahan  
Confirmation No.: 8891  
Docket No.: MTS-520US4

**COMMUNICATION UNDER 37 CFR § 1.312**  
**FOR CORRECTED NOTICE OF ALLOWABILITY**

**MAIL STOP ISSUE FEE**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Responsive to the Notice of Allowability mailed on **January 14, 2009**, a corrected Notice of Allowability is respectfully requested. The Notice of Allowability includes two errors:

1) The allowed claims in the above-identified application are claims 32 and 33. It is requested that a Supplemental Notice of Allowability be mailed to Applicants' representative which acknowledges allowance of claims 32 and 33. The previously mailed Notice of Allowability erroneously identifies claims 31 and 32 as being allowed.

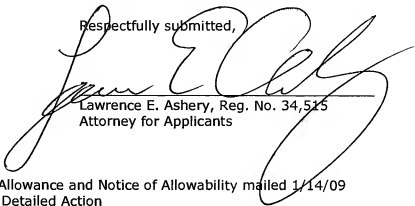
2) The Notice of Allowability mailed on **January 14, 2009**, was issued responsive to a Supplemental Declaration which was filed on October 31, 2008. The Notice of Allowability erroneously states that allowance is responsive to an RCE filed on November 19, 2004. It is respectfully requested that a Notice of Allowability be issued in which the Declaration filed on October 31, 2008, be acknowledged.

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Issuance of a Supplemental Notice of Allowability is respectfully requested.

Respectfully submitted,

A large, stylized handwritten signature in black ink, likely belonging to Lawrence E. Ashery, is written over a horizontal line.

Lawrence E. Ashery, Reg. No. 34,515  
Attorney for Applicants

LEA/fp

Enclosures: Copy of Notice of Allowance and Notice of Allowability mailed 1/14/09  
Copy of page 2 of Detailed Action

Dated: February 18, 2009

P.O. Box 980  
Valley Forge, PA 19482  
(610) 407-0700

FP\_408644

MJC



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

Issue

Fee 4/14/09 AMH

## NOTICE OF ALLOWANCE AND FEE(S) DUE

7590

01/14/2009

Allan Ratner  
Ratner & Prestia  
P.O. Box 980  
Valley Forge, PA 19482

RECEIVED

JAN 16 2009

RatnerPrestia

EXAMINER

CALLAHAN, PAUL E

ART UNIT

PAPER NUMBER

2137

DATE MAILED: 01/14/2009

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,965	12/07/2001	Mitsuaki Oshima	MTS-520US4	8891

TITLE OF INVENTION: MARK FORMING APPARATUS, METHOD OF FORMING LASER MARK ON OPTICAL DISK, REPRODUCING APPARATUS, OPTICAL DISK AND METHOD OF PRODUCING OPTICAL DISK

APPLN. TYPE	SMALL ENTITY	ISSUE FEE DUE	PUBLICATION FEE DUE	PREV. PAID ISSUE FEE	TOTAL FEE(S) DUE	DATE DUE
nonprovisional	NO	\$1510	\$0	\$0	\$1510	04/14/2009

THE APPLICATION IDENTIFIED ABOVE HAS BEEN EXAMINED AND IS ALLOWED FOR ISSUANCE AS A PATENT. **PROSECUTION ON THE MERITS IS CLOSED.** THIS NOTICE OF ALLOWANCE IS NOT A GRANT OF PATENT RIGHTS. THIS APPLICATION IS SUBJECT TO WITHDRAWAL FROM ISSUE AT THE INITIATIVE OF THE OFFICE OR UPON PETITION BY THE APPLICANT. SEE 37 CFR 1.313 AND MPEP 1308.

THE ISSUE FEE AND PUBLICATION FEE (IF REQUIRED) MUST BE PAID WITHIN **THREE MONTHS** FROM THE MAILING DATE OF THIS NOTICE OR THIS APPLICATION SHALL BE REGARDED AS ABANDONED. **THIS STATUTORY PERIOD CANNOT BE EXTENDED.** SEE 35 U.S.C. 151. THE ISSUE FEE DUE INDICATED ABOVE DOES NOT REFLECT A CREDIT FOR ANY PREVIOUSLY PAID ISSUE FEE IN THIS APPLICATION. IF AN ISSUE FEE HAS PREVIOUSLY BEEN PAID IN THIS APPLICATION (AS SHOWN ABOVE), THE RETURN OF PART B OF THIS FORM WILL BE CONSIDERED A REQUEST TO REAPPLY THE PREVIOUSLY PAID ISSUE FEE TOWARD THE ISSUE FEE NOW DUE.

## HOW TO REPLY TO THIS NOTICE:

I. Review the SMALL ENTITY status shown above.

If the SMALL ENTITY is shown as YES, verify your current SMALL ENTITY status:

A. If the status is the same, pay the TOTAL FEE(S) DUE shown above.

B. If the status above is to be removed, check box 5b on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and twice the amount of the ISSUE FEE shown above, or

If the SMALL ENTITY is shown as NO:

A. Pay TOTAL FEE(S) DUE shown above, or

B. If applicant claimed SMALL ENTITY status before, or is now claiming SMALL ENTITY status, check box 5a on Part B - Fee(s) Transmittal and pay the PUBLICATION FEE (if required) and 1/2 the ISSUE FEE shown above.

II. PART B - FEE(S) TRANSMITTAL, or its equivalent, must be completed and returned to the United States Patent and Trademark Office (USPTO) with your ISSUE FEE and PUBLICATION FEE (if required). If you are charging the fee(s) to your deposit account, section "4b" of Part B - Fee(s) Transmittal should be completed and an extra copy of the form should be submitted. If an equivalent of Part B is filed, a request to reapply a previously paid issue fee must be clearly made, and delays in processing may occur due to the difficulty in recognizing the paper as an equivalent of Part B.

III. All communications regarding this application must give the application number. Please direct all communications prior to issuance to Mail Stop ISSUE FEE unless advised to the contrary.

**IMPORTANT REMINDER:** Utility patents issuing on applications filed on or after Dec. 12, 1980 may require payment of maintenance fees. It is patentee's responsibility to ensure timely payment of maintenance fees.

COPY

**Notice of Allowability**

Application No.

10/017,965

Examiner

Paul Callahan

Applicant(s)

OSHIMA ET AL.

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to RCE filed 11/19/04. *Should be Dec Filed on 10/31/08.*
2. ☒ The allowed claim(s) is/are 31 and 32. *Should be 32 and 33*
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/560,015.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_\_
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.

*ee*  
EMMANUEL L. MOISE  
SUPERVISORY PATENT EXAMINER

**COPY**

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 11/19/04 has been entered.
2. Claims 31 and 32 are pending in this application and have been examined.

***Drawings***

3. Clean copies of the drawing sheets of the printed Patent have been submitted as per the requirements of 37 CFR 1.173(a)(2). No further drawings submission is required.

***Allowable Subject Matter***

4. Claims 31 and 32 are allowed.
5. The following is an examiner's statement of reasons for allowance:

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The closest prior art in the field, Ikeda (US 5,050,150), singly and in reasonable combination with the other prior art in the field, does not teach the feature found in the claimed invention of formation of a bar-code pattern on a spiral shaped track formed an optical disc.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

#### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following US Patent documents teach systems of bar code indicia pertinent to the Applicant's disclosure:

Willsie	5,120,940
Lee et al.	4,948,955

**COPY**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul E. Callahan whose telephone number is (571) 272-3869. The examiner can normally be reached on M-F from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, Emmanuel Moise, can be reached on (571) 272-3865. The fax phone number for the organization where this application or proceeding is assigned is: (571) 273-8300.

PEC

6/1/06

*Paul Callahan*

**COPY**